

**REMARKS**

Claims 1–2, 4–5 and 9–20 are pending in the present application.

Claims 3 and 6–8 were canceled.

Claims 1, 10 and 20 were amended.

Reconsideration of the claims is respectfully requested.

**Summary of Examiner Interview**

As reflected in the Interview Summary mailed February 24, 2004, in a telephonic Examiner Interview on February 17, 2004, the Applicant and undersigned discussed the pending claims with the Examiner, as well as the cited references. Distinguishing features of the claims and in the specification were discussed, focusing principally on the size and material of construction of the claimed invention, the size of, and appropriateness of equating, features of the structure disclosed in *Kaye* with elements of the claimed invention, and differences in materials of construction of the claimed invention from the structures disclosed in *Kamel et al* and *Krass*, as well as suitability of the structures disclosed in *Kamel et al* and *Krass* for use as a placemat. No agreement was reached regarding proposed amendment of the claims.

**35 U.S.C. § 102 (Anticipation)**

Claims 1–2, 4–5, 9–14 and 16–20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. D181,058 to *Kaye*. Claims 1–2, 4–5, 9–15 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. D266,045 to *Kamel et al*. Claims

1–2, 4–5, 12, 14 and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. D139,954 to *Krass*. These rejections are respectfully traversed.

A claim is anticipated only if each and every element is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. MPEP § 2131 at p. 2100-70 (8<sup>th</sup> ed. rev. 1 February 2003).

Independent claims 1, 10 and 20 recite specific dimensional limitations for both the body and coaster extension portions of the placemat, and limitations regarding the material of construction for the placemat, that are not shown or suggested by the cited references.

Therefore, the rejection of claims 1–2, 4–5 and 9–20 under 35 U.S.C. § 102 has been overcome.

**35 U.S.C. § 103 (Obviousness)**

Claims 6–8, which have been canceled herein, were rejected under 35 U.S.C. § 103(a) as being unpatentable over any of *Kaye*, *Kamel et al* or *Krass*. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-123 (8th ed. rev. 1 February 2003). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142 at p. 2100-124.

The limitations of claims 6–8, which have been incorporated into claims 1, 10 and 20, recite dimensions for the major or body portion of the placemat not shown or suggested by the cited references. In addition, dimensional limitations for the coaster extension as recited in claims 1, 10 and 20 are not shown or suggested by the cited reference.

Therefore, the rejection of claims 6–8 under 35 U.S.C. § 103 has been overcome.


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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